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10/799,423	03/12/2004	David Ray Burritt	403118-A-01-US (Burritt)	7122

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EXAMINER
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WOODS, ERIC V

ART UNIT	PAPER NUMBER
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2628

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/799,423	Applicant(s) BURRITT ET AL.	
	Examiner Eric Woods	Art Unit 2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

Examiner cannot locate support in the parent priority document for any of the claimed 'enhanced visual telecommunication information,' where the concept of 'emphasizing the status information using visual enhancement' exists.

As evidence that examiner does not believe that such support exists, examiner points to page 2 of the instant specification, last paragraph, where it discloses that 'an alternative that provides voice output for blind users is described by previously incorporated patent applications.' Therefore, since it states that 'because this approach relies on voice output, it may not be the preferred UI for an individual who still has some residual vision,' it is implicitly stated that such inventions are **not** covered in the domestic priority documents. Applicant is asked to please point out where such support exists if applicants that such material has such support.

Applicant is advised that as per *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 69 USPQ2d 1865, 1878 (Fed. Cir. 2004), at least one of: A, B ... and C is read to mean requiring at least one A, one B, and one C. Based on the applicant's disclosure, examiner is reading it as "A, B, or C".

Applicant is asked to examine the similarities between these applications: 10/251,249 and 10/406,341 and the instant application.

### *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on 12 March 2004 was filed before the mailing date of a First Action On the Merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose a system using all of the listed combinations as per the reading of the claim in light of Superguide as above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 36 invokes 35 USC 112, sixth paragraph, to obtain protection for means plus function steps. The specification does not specifically point out and set forth what means correspond to which functions. Applicant is required to point out

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which elements in which drawings correspond to the means set forth in each of the apparatus elements in claim 36. It is well established case law that applicants must point out the subject matter they are seeking to claim under 35 USC 112, sixth paragraph, since the scope of coverage of such a claim is necessarily different than a standard apparatus claim. This rejection will be removed once applicant has pointed out which means correspond to what function (please also point out where in the specification and drawings such elements may be found).

### ***Specification***

The abstract of the disclosure is objected to because it is not descriptive enough. Applicant's inventive concept focuses on emphasizing visual information. However, that term and description is so broad as to prevent anyone reading the abstract from understanding what precisely applicant's invention is; therefore, applicant needs to provide an example or more details. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Specifically, the title should be between 2 and 7 words long. This title is too long. Examiner suggests removing the "and method" or "apparatus and" and/or replacing "Apparatus and Method" with "System", because the idea of a system clearly conveys both apparatus and method, and it would significantly shorten the title. Examiner would accept such an amendment and withdrawn the objection therein.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

1. Figure 4 has elements 404 and 406 that are not discussed in the specification (in the correct order, that is, with respect to each other; element 404 is not mentioned at all).
2. Figure 6 has elements 604 and 606, which are not discussed in the specification at all

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

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requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-35 are rejected under 35 U.S.C. 101 because they recite non-statutory subject matter. First of all, there is no structure disclosed for the apparatus claims. Secondly, claims 1 and 15 are evidence that the invention is entirely embodied in software, and applicant is seeking protection for the generic software. This is therefore an issue of preemption and applicant cannot obtain protection for only the software when Computer Program Product /Computer Readable Medium claims and method claims are already present since there is no recited structure. See Interim Guidelines for Patent Subject Matter Eligibility.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Computer program product claims are already apparatus claims. It is

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unknown how an apparatus would implement a computer program product that is already an apparatus.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites means elements that are not clearly defined by the specification. In order for a claim to receive protection under 35 USC 112, sixth paragraph, the various functional elements **and their equivalents** must be pointed out in the specification so that the metes and bounds of the claims are clear. However, in the instant case there is no clarification of what these are.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.



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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnarel et al (US 6,975,712 B1) in view of Wilcox et al (US PGPub 2002/0090980 A1).

As to claims 1, 15, and 29 (Schnarel teaches generic apparatus in Figure 14),  
A method for providing telecommunication terminal status information to people having at least one of poor visual acuity and poor hearing, comprising the steps of:

- Receiving via digital transmission telecommunication terminal status information for a telecommunication terminal; (Schnarel et al teaches signaling protocols to transmit status for a telecommunications terminal (27:5-26), digital telephone answering functions, and the like, where further the terminal is designed to be functional with Web telephones and the like, as described on 4:10-40, Ethernet telephony (5:10-30) e.g. digital environments, as well as "telephone line status information" (Abstract))
- Emphasizing the received telecommunication terminal status information using visual enhancement; and (Schnarel clearly displays enhanced visual information for connected calls and status information – see Figure 1 as call slip 100 in extended form that sits on top of the display (5:10-20), and Figure 5, where such enhanced or enlarged text is discussed as shown as extended call slip 500 / 504 in Figure (5:65-6:10), where such information is enhanced during a call)
- Displaying the emphasized visual telecommunication terminal status information on a visual display separate from the telecommunication terminal. (Wilcox shows that visual displays can be separate from telephone units as in Figure 6 (physically separate) [0060], where this advantageous because it provides larger viewing area [0033-0036] or

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simply separate from the normal display as attached, roll-on devices – Figure 1 [0053-0056])

Schnarel does not expressly teach that the visual display is separate from the telecommunications terminal. Normal telecommunications terminals (e.g. telephone sets) have very small displays that are not capable of displaying much information, as is known in the art (for example, cell phones, see Wilcox background [0003-0005]). It has been held (In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)) that making a thing separable is not a patentable distinction. Schnarel does teach the desirability of large screens for phones.

Wilcox clearly teaches that most phones [0003-0005] have very small displays, and that it is desirable to have a large display (as taught by Schnarel). Wilcox discloses the utility of having both the small and large displays, where the large display can be integral with or separate from the housing containing the small display (Figures 1 and 6, as explained above). For at least the reasons cited in Wilcox as above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit a user to view the expanded information display of Schnarel on a mobile device such as that of Wilcox, thusly extending its utility.

Claims 1-3, 15-17, 29-30, 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forlenza et al (US 6,665,375) in view of Schnarel (US 6,975,712 B1).

As to claims 1, 15, 29, and 36 (Forlenza discloses an apparatus in Figure 2C, and Schnarel in Figure 14, thusly meeting all limitations of generic 'apparatus')

A method for providing telecommunication terminal status information to people having at least one of poor visual acuity and poor hearing, comprising the steps of: (Forlenza 2:10-60)

-Receiving via digital transmission telecommunication terminal status information for a telecommunication terminal; (Forlenza Figure 1, telephones 108 attached to PBX 110 as an example, where this clearly provides digital information, and digital phones (e.g. 104) are also known – 2:40-3:6, where this includes status information 3:50-4:40, such as binary codes and the like, 7:10-25 where the system may deliver status codes directly to the client via the Internet and the like)

-Emphasizing the received telecommunication terminal status information using visual enhancement; and (Forlenza teaches that such call status information is shown to the user and can be maximized and minimized and the like - 9:10-35) (Schnarel clearly displays enhanced visual information for connected calls and status information – see Figure 1 as call slip 100 in extended form that sits on top of the display (5:10-20), and Figure 5, where such enhanced or enlarged text is discussed as shown as extended call slip 500 / 504 in Figure (5:65-6:10), where such information is enhanced during a call, as well as icons concerning the status and the like, 7:35-8:40 and the like, especially including 11:50-60 – this is the most relevant portion)

-Displaying the emphasized visual telecommunication terminal status information on a visual display separate from the telecommunication terminal. (Forlenza teaches that the

call status information and the like are shown on a separate display, such as in Figure 2C such that the user can still have a normal phone and have the separate device which provides said information – 5:20-50)

Forlenza teaches all the limitations of the instant application except teaching that such visual information is emphasized. Schnarel clearly teaches that limitation, as described above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Forlenza to emphasize such information as per Schnarel 2:30-50.

As to claim 36, Forlenza teaches in Figure 2C a device that has means for receiving terminal status information via the PBX system and/or generic digital telephone as discussed above (3:39-45, 5:20-50, as above) with processor and memory and display as in Figure 2C, which clearly constitutes means for displaying etc.

As to claim 2, 16, and 30, 34, Forlenza clearly teaches a separate device containing a computer that controls the display that can be transmitted from a separate PBX system or the like in digital format (Figure 1) as per the citations above.

As to claim 3 and 17, see Schnarel Tables 1 and 2 on column sets (7/8) and (9/10) respectively with an ALERT/FULL state shown, where these are clearly alerts as defined in the specification.

Claims 4-14, 18-28, 31-33, and 35 are rejected under 35 USC 103(a) as unpatentable over Forlenza in view Schnarel as applied to claim 2/16 above, and further in view of Becker et al (US 6,192,341 B1).

As to claim 4 and 18, Forlenza and Schnarel do not expressly teach these limitations. Becker clearly teaches that it is beneficial to display information in a larger format to emphasize it and/or to render it visible to persons with visual impairments and the like (7:12-35), where it would make sense to emphasize status information that is important, as already disclosed by Schnarel in the form of the expanded call slips, which is cited above and found in 4:50-60, 6:25-45, 11:50-60). However, Schnarel does not expressly address the situation of users with low visual acuity but emphasizes that showing alert information in a larger format, but does not expressly disclose using a larger font or the like. Becker teaches several methods of doing so and that such is beneficial for at least visually impaired users (7:12-35), so such a combination would have been obvious to a PHOSITA at the time the invention was made for those reasons.

As to claim 5 and 19 and 35, clearly the expanded call slip of Schnarel is a different form, but since it is unknown how applicant is defining the term, Becker clearly teaches showing such information in a "different visual form" such as by changing the contrast, color schema, etc (7:10-20).

As to claim 6 and 20, Becker clearly discloses changing the contrast ratio, changing the font and the colors thereof, and Schnarel teaches having a large unique area of the display with the expanded call slip area and the like.

As to claim 7 and 21, Becker generates such audio information in 7:35-55, and 3:35-55, and the like, as well as Forlenza 6:19-38.

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As to claim 8, 22, and 31, Forlenza teaches that the digital phones can directly communicate with the PBX switches and the like as described above. Specifically, Forlenza states that the computer (client) may directly access the status information or have it go through the additional servers as set forth in 7:5-36, therefore it would be obvious that route choice would be whatever implementation was desirous to the user and applicant has not demonstrated any criticality to this particular feature and Forlenza clearly teaches that the user can do if it is more convenient and/or the like.

As to claim 9 and 23, Becker clearly teaches displaying such data in the larger font (7:12-35) and the like.

As to the claim 10 and 24, see claim 5 above.

As to claim 11 and 25, see claim 6 above.

As to claim 12 and 26, see claim 7 above.

As to claim 13, 27, and 32, Forlenza 6:40-65 teaches that the system utilizes the Internet and a TCP/IP protocol stack, where it is known in the art that TCP/IP utilizes sockets. For example, Schnarel cites several publications concerning smart phones and the like that utilize Java (for web phones, etc), which is well known to use the socket programming paradigm. Therefore, examiner takes Official Notice that both the concept and advantage of the use of sockets in TCP/IP systems is well known and expected in the art. Therefore it would have been obvious to one of ordinary skill in the art to use sockets for TCP/IP in order to make programming implementations easier and at a higher level of object orientation (see Java).

As to claim 14 and 28, see above for claim 13, since that if the connection is made via an IP socket, obviously the data will be read through such a socketed connection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric Woods

September 28, 2006

  
ULKA CHAUHAN  
SUPERVISORY PATENT EXAMINER